

REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested.

Upon entry of this amendment, claims 1, 3, 7, 8, 12, 13, 16-21, 39-50 will be pending in the present application. Claims 2 and 4 have been cancelled. Notice of the allowability of claim 21 is appreciated.

In response to the Examiner's "Response to Arguments" regarding claims 1, 19, and 20, the applicant contends that functional language cannot be stricken from the claim as proposed by the examiner. It is impermissible for the Patent Office to refuse to provide patentable weight to functional limitations. *See, e.g., In re Land*, 151 U.S.P.Q. 621 (C.C.P.A. 1966) in which the court held that portions of a disputed claim were functional, but nevertheless held the claim patentable over the prior art in view of the functional limitations. The Patent Office must afford patentable weight to functional limitations even if the functional limitations are the only limitations that are nonobvious over the prior art. *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). *See also In re Atwood*, 148 U.S.P.Q. 203,210 (C.C.P.A. 1966)("[w]e have here a combination claims and the limitations ignored by the board as use limitations we think are functional expressions which must be given weight"); *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir.), *reh'g en banc granted*, 116 F.3d 874 (Fed. Cir. 1997). In addition, the Manual of Patent Examining Procedure ("M.P.E.P.") expressly authorizes the use of functional language and specifically acknowledges that "[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it conveys to a person of ordinary skill in the pertinent art in the context in which it is used." M.P.E.P. § 2173.05(g) (8th Ed. 2001). Accordingly, the applicant requests reconsideration of claims 1, 19, and 20 including consideration of the functional limitations.

Claims 42, 43, 45, 45, 49, and 50 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the examiner rejected to these

dependent claims for being inconsistent with the preamble of the independent claims 39, 40, and 47. However, the applicant contends that claims 42, 43, 45, 46, 49, and 50 satisfy 112, second paragraph. In essence this rejection is similar to the examiner's position regarding functional limitations addressed above. These dependent claims are merely further limiting the functional limitations present in the pending independent claims. Functional limitations are to be considered as noted above. The applicant contends that further defining the functional limitations of the independent claims in the dependent claims is permissible. Accordingly, the applicant requests reconsideration of this rejection and allowance of claims 42, 43, 45, 46, 49, and 50.

Claims 39-41, 44, 47, and 48 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent No. 4,617,557 ("the '557 patent"). The Gordon patent discloses a medication compliance aid for unit dose packaging. The medical package includes electronic circuitry that has a timer and alarm to act as a medication compliance aid. In addition, the '557 patent discloses that a radio telemetry linkup may be established between the medical package and a separate housing which may be stored in a purse or pocket.

In contrast with the device described in the '557 patent, independent claims 39, 40, and 47 all include the limitation that "... the data carrier is arranged to be powered inductively from a radio frequency signal transmitted from or associated with the drug delivery device..." (emphasis added). The applicant submits that this limitation is not disclosed or suggested in the '557 patent. Accordingly, the applicant requests reconsideration of this rejection and allowance of claims 39-41, 44, 47, and 48.

Claims 13, 17, 18, and 20 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,237,987 to Anderson et al. ("the '987 patent"). The '987 patent discloses a human lung ventilator system that includes gas flow controllers that mix air and oxygen. In addition, the system includes a filter, humidifier, water trap, PEEP system, and nebulizer. Additionally, Claim 13 stands rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,590,648 to Mitchell et al. ("the '648 patent"). The '648 patent discloses a personal healthcare system. The described healthcare system is a unitary command center having

a computer for receiving, storing, processing, and transmitting information, and a plurality of interfacing ports. Each interfacing port is adapted to accept a plurality of different sensor, accessory, and therapy-providing modules.

As amended, independent claims 13 and 20 both recite that “the input is a radio frequency input which receives the treatment information from the electronic data carrier over a radio frequency signal. . . ” (emphasis added). Although Fig. 1 of the ‘987 patent appears to show that the nebulizer is in communication with the controller subsystem, this connection is not wireless. Similarly, as recognized by the examiner at paragraph 21 of the present office action, the ‘648 patent suffers from the same deficiency. Namely, the ‘648 patent does not disclose use of a radio frequency input. Accordingly, reconsideration and allowance of dependent claims 13, 17, 18, and 20 is requested.

Claim 19 stands rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,505,195 to Wolf et al. (“the ‘195 patent”). Claims 1-4, 7, 8, and 12 stand rejected under 35 U.S.C. § 103 as being anticipated by U.S. Patent No. 5,505,195 to Wolf et al. (“the ‘195 patent”) in light of the examiner’s notice. Specifically, the examiner stated that the ‘195 patent discloses all of the limitations of the above-referenced claims except for the plurality of containers. The examiner has taken notice that replacing a single container with a plurality of containers is merely a duplication of parts.

The dry dose powder inhalant device disclosed in the ‘195 patent is mounted on a dry powder dispenser having a mouthpiece to deliver dry powder medication to a patient. The device includes a housing that is mounted on the dispenser to hold electronics. The electronics comprise proximity reed switches to record when the device has been set and loaded to deliver a dose of medication. The electronics also include a fast response thermistor for measuring when a sufficient air flow is being drawn into the housing.

In response, the applicant has amended the claims to remove recitation of a plurality of containers. However, the applicant contends that this rejection is overcome nonetheless since the ‘195 patent does not teach or suggest an electronic data carrier that “includes a radio frequency device for transmitting the drug treatment information to the drug

delivery device” as recited in the claim 1 (emphasis added). First, the ‘195 patent does not disclose a radio frequency device. As such, this rejection is overcome on this basis alone. In addition, the ‘195 patent does not disclose transmitting the drug treatment information to the drug delivery device. If the examiner construes the housing as an electronic data carrier, this device does not communicate with the drug delivery device. Fig. 10 shows a wire 1040 that merely connects the push-buttons 1010 with the microprocessor 405 within the housing 110. Wire 1040 does not permit any communication whatsoever between the housing 110 and MDI dispenser 140 or activation sheath 120. In addition, the applicant would like to point out that claims 2 and 4 are no longer pending in the present application. Accordingly, reconsideration of this rejection and allowance of claims 1, 3, 7, 8, 12, and 19 is requested.

Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being anticipated by U.S. Patent No. 5,590,648 to Mitchell et al. (“the ‘648 patent”) in view of U.S. Patent No. 5,593,390 to Castellano et al. (“the ‘390 patent”).

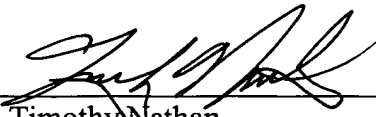
Claim 15 has been deleted with the subject matter of this claim being incorporated into Claim 13. As recognized by the examiner, the ‘648 patent fails to disclose electronic data carrier wherein the input is a radio frequency input which receives the treatment information from a radio frequency input. The applicant contends that this deficiency is not supplemented by the ‘390 patent. Although there is a brief disclosure in the ‘390 patent that the pen-type injector may include an I/O port 46 for communicating with an external computer. This disclosure still does not meet several of the limitations in claims 13 and 16. No treatment information is delivered to the pen-type injector from an electronic data carrier. The disclosed system merely allows communication between an external computer and the pen-type connector. Accordingly, reconsideration and allowance of claim 16 is requested.

This response is being filed within three-months after the three-month statutory response period which expired on June 16, 2006. The Commission is authorized to charge these fees as well as any other fee required under 37 C.F.R. §§ 1.16 or 1.17 to deposit account no. 50-0558.

DENYER et al. -- Appln. No.: 09/781,610

All objections and rejections have been addressed. It is respectfully submitted that the present application is in condition for allowance and a Notice to the effect is earnestly solicited.

Respectfully submitted,

By 
Timothy Nathan
Reg. No.: 44,256
Tel. No.: (724) 387-4435
Fax No.: (724) 387-5021

RESPIRONICS, INC.
1010 Murry Ridge Lane
Murrysville, PA 15668-8525